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PATENTS

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Olimpia Jakubowska Date 5/12/06  
Olimpia Jakubowska Wrobel

Attorney's Docket No. 101384-22

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 10/629,380 Confirmation No.: 6539  
Applicant : Kirk E. Vandezande  
Title : Hierarchical Optimization for Procedural Effectiveness  
Filed : July 29, 2003  
TC/A.U. : 1631  
Examiner : ZHOU, Shubo  
Customer No. : 27,388

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**RESPONSE TO ELECTION / RESTRICTION REQUIREMENT**

Sir:

This is in response to the Restriction Requirement mailed March 13, 2006, in the above-identified application.

In the Requirement, the Examiner stated that the application contains patentably distinct species:

In the Office Action, the following restriction groups are indicated:

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Group I: 1-14, as drawn to a method and system for determining an optimal test order for diagnosing mutation involving applying a match pattern, classified in class 702, subclass 19; and

Group II: 15-18, drawn to a method and system for determining an optimal test order for diagnosing mutation involving applying a match pattern, classified in class 702, subclass 19.

In response, Applicant elects Group I (claims 1-14), with traverse.

Applicants respectfully traverse the restriction requirement for the following reasons:

At page 3 of the office action, the Examiner states that a search and examination of both groups of claims would constitute an undue burden, since “[s]earching both groups together would involve searching all the distinct subject matter including decision tree algorithm and match pattern methods.”

According to the Examiner, “[b]ecause these inventions are independent/distinct..., they have acquired a separate status in the art”. The Applicant respectfully disagrees.

In MPEP 808.02 inventions have acquired a separate status in the art, when “each invention can be shown to have formed a separate subject for inventive effort when the Examiner can show a recognition of separate inventive effort by the inventors. Separate status in the art may be shown by citing patents which are evidence of such separate status, and also of a separate field of search.” With respect, in this case the Examiner has not cited any patents which provide evidence of such separate status. In fact, as shown on page 1 of the office action, each group of claims has been classified in the same class and subclass (class 702, subclass 19). According to MPEP 808.02, restriction is not required “where the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search.”

Consequently, examination of both groups of claims would not constitute a “serious burden”, and the Applicant respectfully submits that the Examiner has not shown otherwise. If the search and examination of all the claims in an application can be made without serious burden, the Examiner must examine them on the merits, even though they may include claims to independent or distinct inventions.

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**Conclusion**

Applicant respectfully requests traversal of the restriction requirement as set forth in the Office Action of March 13, 2006 such that all claims can be prosecuted together..

The Commissioner is authorized to appropriately charge or credit any fee that is due as a result of filing this paper to Deposit Account No. 14-1263, reference 101384-22, of Norris McLaughlin & Marcus, PA.

If the Examiner feels that a telephone conference would be helpful, please contact the undersigned at 212-808-0700.

Issuance of an Office Action on the merits examining all claims is earnestly solicited.

**CONDITIONAL PETITION FOR EXTENSION OF TIME**

If entry and consideration of the amendments above requires an extension of time, Applicants respectfully request that this be considered a petition therefor. The Assistant Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

**ADDITIONAL FEE**

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

Respectfully submitted,



Christa Hildebrand,  
Reg. No. 34,953  
Attorney for Applicants  
Norris McLaughlin & Marcus P.A.  
875 Third Avenue – 18<sup>th</sup> Floor  
New York, N.Y. 10022  
Telephone: (212)808-0700  
Facsimile: (212)808-0844

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